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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,213	07/18/2003	Jack L. Becker	BKR-101	2853
21272	7590	04/20/2004	EXAMINER	
MORLAND C FISCHER 2030 MAIN ST SUITE 1050 IRVINE, CA 92614			PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 04/20/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/623,213	BECKER, JACK L.	
Examiner	Art Unit		
Alton N. Pryor	1616		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-6 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,2 and 4-6 is/are rejected.

7)  Claim(s) 3 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

#### **I. The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 2 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating plant fungi, does not reasonably provide enablement for curing plant fungi. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. The asserted utility is not believable on its face. It is not known how a method wherein a composition is claimed can be administered to cure plant fungi. The state of the art is what prior art knows about the invention. There is no known art wherein a certain composition is administered to successfully cure plant fungi. The level of ordinary skill in the art is high but only in the art of treating / controlling said fungi. The predictability or lack thereof in the art refers to the ability of one skilled in the art to extrapolate the disclosed or known results to the claimed invention. The lower the predictability, the higher the direction and guidance that must be provided by the applicant. In the instant invention the predictability is very low and consequently, the need for the higher levels of direction

and guidance by the applicant. However, the amount of direction and guidance provided by the applicant is limited to treatment or control. There is no evidence in the specification that established correlation between the experiment and the claimed utility. The quantity of experimentation required to use the method as claimed in the instant invention, based on applicant's disclosure would be undue because, one of ordinary skill in the art would have performed significant amount of experiments.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson et al (US 2003/0113421; 6/19/03). Wilson teaches a method of applying a composition comprising essential oils such as carvacrol or thymol to post harvested fruits. See paragraph 12. Wilson teaches that the composition is applied to peaches and nectarines. See paragraph 15. Wilson teaches that the composition can be applied as an aqueous spray. See paragraphs 26, 28. Wilson does not explicitly teach the method comprising applying the composition to a peach tree. However, it is inherent that post harvest would include the application of the composition to the tree.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ninkov (US 2002/0156135; 10/24/02). Ninkov teaches a method of applying a composition comprising carvacrol and thymol to plants or trees to control fungal growth. See abstract, paragraphs 20,22,25,28,64,70,80,106,127,128,131,132. Ninkov teaches that the composition is applied to cherry trees. See paragraphs 135,136. Ninkov teaches that the composition can be applied as an aqueous spray. See paragraphs 83, 90. Ninkov does not teach the method comprising applying the composition to a peach tree. Ninkov also does not teach the instant method comprising instant ratio of carvacrol to water. In the absences of unexpected data, it would have been obvious to one having ordinary skill in the art to apply the composition to a peach tree. One would have been motivated to do this since a cherry tree and a peach tree are species in the stone tree genus. See USPN 4,950,491 claim 4. Species within a genus would have been expected to yield similar results when introduced to identical conditions. With respect to amounts or ratios of ingredients, it would have been obvious to determine the optimum ratio of carvacrol to water. One would have been motivated to do this in order to develop the most effective method for controlling fungal growth on stone fruit trees such as cherry and peach trees.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson as applied to claims 1,2 above. See 102(e) rejection above. Wilson teaches all that is recited in claims 4-6 except for the method comprising a combination of carvacrol

and thyme oil. Wilson also does not teach the instant method comprising the instant ratio of carvacrol to water. It would have been obvious to one having ordinary skill in the art to make the instant method comprising both thyme oil and carvacrol. One would have been motivated to do this since Wilson teaches that both oils are effective in controlling the growth of pests on fruit. With respect to amounts or ratios of ingredients, it would have been obvious to determine the optimum ratio of carvacrol to water. One would have been motivated to do this in order to develop the most effective method for controlling fungal growth on post harvested peaches.

***Claim Objection***

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not teach or suggest the instant method comprising oregano oil.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alton N. Pryor  
Primary Examiner  
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